

REMARKS

I. Summary of Office Action

Claims 1-27 are pending.

The Examiner rejects claims 1-4, 6-9, 11-14, 17, 21-23, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Hammond et al. U.S. patent 5,090,350 (hereinafter "Hammond").

The Examiner rejects claims 1-3, 6, 17, 21, 22, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Jenkins U.S. patent 4,73,575 (hereinafter "Jenkins").

The Examiner rejects claims 1, 4, 6, 17, 21, 23, and 25 under 35 U.S.C. § 102(b) as being anticipated by Wrench U.S. patent 3,390,661 (hereinafter "Wrench").

The Examiner rejects claims 1, 2-4, 6-10, 17, 21-23, and 26 under 35 U.S.C. § 102(b) as being anticipated by Swain et al. U.S. patent 5,433,572 (hereinafter "Swain").

The Examiner rejects claims 11-14, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Hammond.

The Examiner rejects claims 5 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Masahumi U.S. patent 5,254,164.

The Examiner rejects claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Hammond, Toussaint et al. U.S. patent 3,619,240

(hereinafter "Toussaint"), and Allen et al. U.S. patent 3,901,180 (hereinafter "Allen").

The Examiner objects to claims 15 and 20 as being dependent upon a rejected base claim but indicates that these claims would be allowable if rewritten in independent form including all of the features of the base claim and intervening claims.

II. Summary of Applicants' Reply

Applicants have canceled claims 5 and 24. Applicants have amended claims 1 and 21 to incorporate the features of canceled claims 5 and 24, respectively, and to more particularly define the invention. Applicants have amended claim 4 and 25 to correct typographical errors. Applicants gratefully acknowledge the Examiner's indication that claims 15 and 20 are allowable.

The Examiner's objection and rejections are respectfully traversed.

III. Applicants' Invention

Applicants' invention, as set forth by currently amended independent claims 1 and 21, is directed toward apparatus for performing a resin application process for dynamo-electric machine components. The apparatus includes a cabinet for providing a controlled ambient and a rotating vertical support structure disposed in the cabinet. The

rotating vertical support structure has a plurality of fixtures disposed in an annular region thereon configured to hold the machine components. The component holding fixtures are open structures configured to allow air to circulate through the fixtures to expose substantial surface portions of the held components to the controlled ambient.

IV. Applicants' Reply to the Examiner's Rejections Under 35 U.S.C. § 102(b)

The Examiner rejects claims 1-4, 6-9, 11-14, 17, 21-23, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Hammond. The Examiner rejects claims 1-3, 6, 17, 21, 22, 25, and 26 under 35 U.S.C. § 102(b) as being anticipated by Jenkins. The Examiner rejects claims 1, 4, 6, 17, 21, 23, and 25 under 35 U.S.C. § 102(b) as being anticipated by Wrench. The Examiner rejects claims 1, 2-4, 6-10, 17, 21-23, and 26 under 35 U.S.C. § 102(b) as being anticipated by Swain. Applicants have amended claims 1 and 21 to incorporate the features of canceled claims 5 and 24, respectively, and to more particularly define the invention. Applicants have amended claims 4 and 25 to correct typographical errors. The Examiner's rejections are respectfully traversed.

Applicants submit that independent claims 1 and 21 are allowable over each of Hammond, Jenkins, Wrench,

and Swain at least because none of these references show the feature of applicants' claims 1 and 21 which requires component holding fixtures that comprise open structures configured to allow air to circulate through the fixtures to expose substantial surface portions of the held components to the controlled ambient. Applicants note that canceled claims 5 and 24, the features of which have been respectively incorporated into independent claims 1 and 21, were not rejected by the Examiner under § 102 in the Office action.

Therefore, for at least the foregoing reasons, applicants submit that independent claims 1 and 21, and dependent claims 2-4, 6-20, 22, 23, 25, and 26 are allowable over each of Hammond, Jenkins, Wrench, and Swain. Accordingly, applicants respectfully request that the § 102 rejections based on these references be withdrawn.

V. Applicants' Reply to the Examiner's Rejections Under 35 U.S.C. § 103(a)

The § 103 Rejection Based On Swain and Masahumi

The Examiner rejects claims 5 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Masahumi. Applicants have canceled claims 5 and 24. Applicants have amended claims 1 and 21 to incorporate the features of canceled claims 5 and 24,

respectively, and to more particularly define the invention.. The Examiner's rejection is respectfully traversed on the basis of independent claims 1 and 21.

Swain is directed toward a rotary atomization manufacturing system for manufacturing photoreceptors from cylindrical substrate members. The system includes a plurality of support structures 22 for receiving and retaining cylindrical substrate members 14. The support structures are correspondingly indexed in a circular pattern on rotatable carrier unit 44 and loading magazine 24. The loading magazine loads the unprocessed cylindrical substrate members onto the carrier member for processing and similarly unloads the processed cylindrical substrate members.

Masahumi is directed toward a system for spray coating and curing cans. The system includes a plurality of vacuum chucks 126 that extend radially from the edges of a rotatable turret 13 for securing the cans while they are sprayed and cured. A vacuum chuck is used at each station of the process (loading, spray coating, curing, and unloading) to enable continuous operation as the turret rotates.

The Examiner contends that Swain "disclose[s] all the limitations of claims 5 and 24, but do[es] not disclose said fixtures to comprise open structures that allow air to circulate there through" but that "Masahumi discloses an

open structure fixture" (page 8, lines 8-11 of Office action). The Examiner contends that "[t]herefore it would have been obvious to one of ordinary skill in the art at the time of the invention to design the fixtures with an open structure to seal and adequately hold the substrate in place" (page 8, lines 12-14 of Office action).

Applicants submit that independent claims 1 and 21 are patentable over Swain and Masahumi at least because neither of these references show or even suggest component holding fixtures that comprise open structures configured to allow air to circulate through the fixtures to expose substantial surface portions of the held components to the controlled ambient. Contrary to the Examiner's contention that Masahumi compensates for this deficiency in Swain by disclosing an "open structure fixture," applicants submit that Masahumi merely shows vacuum chucks 126 having inner bores 148 that provide the requisite vacuum suction for "tight sealing engagement against a can or can end so as to securely hold the can or can end by vacuum as it is indexed around the turret 13" (col. 7, lines 39-41 of Masahumi). Masahumi shows that once vacuum chuck head 145 comes into sealing engagement against the can to hold the can, inner bore 148 no longer communicates with the ambient and cannot possibly allow air to circulate through the fixture to expose substantial

surface portions of the held component to the controlled ambient.

Accordingly, for at least the foregoing reason, applicants submit that independent claims 1 and 21 are patentable over Swain and Masahumi and request that the § 103 rejection based on these references be withdrawn.

Applicants further submit that the § 103 rejection based on Swain and Masahumi must be withdrawn for another independent reason. The Office Action failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP §§ 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

In the Office Action, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to design the fixtures with an open structure to seal and adequately hold the substrate [of Swain] in place" (page 8, lines 12-14 of Office action). Applicants submit that such "[b]road

conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on applicants' "disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

The Examiner's proffered motivation is clearly insufficient under the above-stated standard to motivate one of ordinary skill in the art to replace support structures 22 of Swain with the vacuum chucks 126 of Masahumi. In fact, nowhere in Swain is it suggested that vacuum suction may be used to replace shafts 22 as the means to receive and retain the cylindrical substrate members 14. To the contrary, because the cylindrical substrate members of Swain must receive shafts 22 from both ends of its longitudinal axis, members 14 must possess openings at both ends of the cylindrical member and lack the flat surfaces (i.e., can ends) required for use with the vacuum chucks of Masahumi. Therefore, for all of the foregoing reasons, applicants submit that the Examiner has

failed to provide the requisite motivation to combine Matthews with Lawler.

Accordingly, applicants submit that independent claims 1 and 21 are patentable over Swain and Masahumi and respectfully request that the § 103 rejection based on these references be withdrawn.

The Other § 103 Rejections

The Examiner rejects claims 11-14, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Hammond. The Examiner rejects claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Swain in view of Hammond, Toussaint, and Allen. The Examiner's rejections are respectfully traversed.

In view of the foregoing, applicants submit that independent claim 1 is patentable. Therefore, claims 11-14, 16, 18, and 19, which depend from independent claim 1, are also patentable. Accordingly, applicants respectfully request that the § 103 rejections of claims 11-14, 16, 18, and 19 be withdrawn.

VI. Applicants' Reply to the Examiner's Claim Objection

The Examiner objected to claims 15 and 20 as being dependent upon a rejected base claim. Applicants submit that, in view of the foregoing, independent claim 1

is allowable. Therefore, applicants respectfully request that this objection be withdrawn.

VII. Conclusion

In view of the foregoing, this application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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